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FEB 12 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Case No. 05-1082)

In the Application of:	)	Examiner: Karikari, Kwasi
Lutz Wolfgang Gruneberg et al.	)	Group Art Unit: 2617
Serial No. 10/565,955	)	Confirmation No. 8456
Filed: January 26, 2006	)	Fax No. (571) 273-8300
For: A Method and System to Enable Email Services for Mobile Devices	)	Total Pages: 13

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

FACSIMILE TRANSMITTAL LETTER

In regard to the above identified application:

1. We are transmitting herewith the attached

SUMMARY FOR EXAMINER INTERVIEW OF FEBRUARY 17, 2009

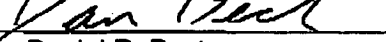
2. With respect to additional fees:

- ☒ A. No additional fee is required.
- ☐ B. Attached is a check in the amount of \$ 0.00.
- ☐ C. Charge the total fee due or credit any overpayment to our Deposit Account No. 13-2490. A duplicate copy of this sheet is enclosed.

3. CERTIFICATE UNDER 37 CFR 1.8(a). The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being transmitted to the USPTO facsimile number 571-273-8300, according to 37 CFR 1.6(d) addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, ATTN: Karikari, Kwasi.

Respectfully Submitted,  
McDonnell Boehnen Hulbert & Berghoff LLP

Date: February 12, 2009

By:   
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For: A Method and System to Enable Email	)	Customer No. 20306
Services for Mobile Devices	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**SUMMARY FOR EXAMINER INTERVIEW OF FEBRUARY 17<sup>TH</sup>, 2009**

Dear Sir:

Applicants thank the Examiner for agreeing to a telephonic interview on February 17<sup>th</sup>, 2009 at 10:00 AM Eastern Standard Time to discuss the outstanding Final Office Action in the above-referenced United States Patent Application.

Applicants note that representatives of the named inventors will be participating in this teleconference, and that Applicants have requested that the Examiner's supervisor, Charles N. Appiah, also participate in the teleconference.

In anticipation of the teleconference, the Examiner requested that the Applicants submit an interview summary outlining the topics of discussion and Applicants' positions. Accordingly, a current status of the claims, along with proposed amendments, and our remarks and summary follow.

**SAMPLE AMENDMENTS**  
**FOR DISCUSSION PURPOSES ONLY**

1. (Previously Presented) A system for handling email requests for sending and receiving email from a terminal, the system comprising  
  
at least one email proxy and a database, the email proxy being arranged to communicate with the database,  
  
wherein the email proxy is arranged to detect a network address of the terminal and retrieve email configuration settings from the database using the network address of the terminal,  
  
the email proxy further being arranged to communicate with an email server using the retrieved email configuration settings.
2. (Currently Amended) The system ~~System~~ according to claim 1, wherein the retrieved email configuration settings include a name of the email server, and username and a password for accessing the email server.
3. (Currently Amended) The system ~~System~~ according to claim 2, wherein the retrieved email configuration settings further include a full name of a user, and an email address of the user.
4. (Currently Amended) The system ~~System~~ according to claims 1, wherein the database comprises a mapping of the network address of the terminal to an identity of a user.

5. (Currently Amended) The system ~~System~~ according to claim 4, wherein a first database comprises the mapping of the network address of the terminal to the identity of the user, and second database comprises the retrieved email configuration settings.

6. (Currently Amended) The system ~~System~~ according to claim 1, wherein a first email proxy is used to handle email requests for retrieving email messages, and a second email proxy is used to handle email requests for sending email messages.

7. (Currently Amended) An email ~~Email~~ retrieval proxy for handling email retrieval requests from a terminal,

the email retrieval proxy being arranged to detect a network address of the terminal, and to then retrieve email configuration settings from a database using the network address of the terminal,

the email retrieval proxy further being arranged to forward the email retrieval request to an email server using the retrieved email configuration settings,

retrieve a requested email message from the email server and forward the requested email message to the terminal.

8. (Currently Amended) An email ~~Email~~ sending proxy for handling email sending requests from a terminal,

the email sending proxy being arranged to detect a network address of the terminal, and  
to then retrieve email configuration settings from a database using the network address of the  
terminal,

the email sending proxy further being arranged to modify the email sending request using  
the email configuration settings and forward the modified email sending request to an email  
server using the email configuration settings.

9. (Currently Amended) A terminal (1) for use with a system of claim 1,

the terminal (1) being provisioned with default configuration settings for sending or  
retrieving email messages, the default configuration settings being the same for mobile terminals  
within a network, wherein the mobile terminal is arranged to send or retrieve email messages  
using the default configuration settings.

10. (Previously Presented) A method for handling email requests from a terminal in at  
least one email proxy, the method comprising the steps of

detecting a network address of the terminal;

retrieving email configuration settings from a database using the network address of the  
terminal; and

communicating with an email server using the email configuration settings.

11. (Currently Amended) The method ~~Method~~ according to claim 10, wherein the email configuration settings include a name of the email server, and a username and a password for accessing the email server.

12. (Currently Amended) The method ~~Method~~ according to claim 11, wherein the retrieved email configuration settings further include a full name of a user, and an email address of the user.

13. (Currently Amended) The method ~~Method~~ according to claim 10, wherein the database comprises a mapping of the network address of the terminal to an identity of a user.

14. (Currently Amended) The method ~~Method~~ according to claim 13, the method comprising the steps of retrieving from a first database information about the mapping of the network address of the terminal (1) to the identity of the user; retrieving from a second database the retrieved email configuration settings.

15. (Currently Amended) The method ~~Method~~ according to claim 10, wherein first email proxy is used to handle email requests for retrieving email messages, and a second email proxy is used to handle email requests for sending email messages.

## REMARKS

### 1. Status of the Claims

Claims 1-15 are currently pending, of which claims 1, 7, 8, and 10 are independent and the remainder dependent. The sample claim amendments set forth above are for discussion purposes only during the teleconference with the Examiner. Applicants submit that no amendments to the claims are necessary to overcome the Examiner's asserted rejections.

### 2. Summary of the Office Action

In the Final Office Action mailed December 4, 2008, the Examiner rejected claims 1, 4-10, and 13-15 under 35 USC § 102(e) as being allegedly anticipated by U.S. Patent No. 7,155,479 ("Cover"). The Examiner rejected claims 2-3 and 11-12 under 35 U.S.C. § 103(a) as being allegedly obvious over Cover in view of Applicant Admitted Prior Art ("AAPA").

### 3. Response to Rejections and Summary of Interview Topics

#### a. Cover Fails to Disclose Each and Every Element of Claims 1, 4-10, and 13-15

The Court of Appeals for the Federal Circuit has held that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As discussed more fully in the following sections, Applicants submit that the Cover reference fails to anticipate each and every element of the currently claimed invention.

First, Cover fails to disclose the claim limitations of claims 1, 7, 8, and 10 requiring that the email proxy "detect a network address of the requesting terminal," and that the email proxy "use the detected network address of the terminal to retrieve email configuration settings" for the requesting terminal "from a databasc of email configuration settings."

Second, Cover fails to disclose the claim limitations of claims 1, 7, 8, and 10 requiring further communication between the email proxy and an email server using the retrieved email configuration settings.

Third, Cover fails to disclose the limitation of, for example, claim 7 relating to the forwarding of the email retrieval request to the email server, and fails to disclose the actual retrieval of an email message by the email proxy and forwarding of the email message to the requesting terminal.

Fourth, Cover fails to disclose the limitation of, for example, claim 8, relating to modifying the email sending request using the email configuration settings and forwarding the modified email sending request to an email server.

Fifth, and finally, regarding claims 7 and 8, Cover fundamentally fails to disclose receipt of an email retrieval request.

**b. Cover fails to disclose the claim limitations of claims 1, 7, 8, and 10 relating to the network address of the requesting terminal.**

Cover fails to disclose the claim limitations of claims 1, 7, 8, and 10 requiring that the email proxy "detect a network address of the requesting terminal," and that the email proxy "use the detected network address of the terminal to retrieve email configuration settings" for the requesting terminal "from a database of email configuration settings."

Applicants submit that it is well known to one of ordinary skill in the art that a network address is a unique address assigned to each terminal in a network for identifying and differentiating between devices in a network. For example, and as set forth on page 10 of Applicant's disclosure, a network address of a terminal could be an IP address.

In accordance with the claimed invention, the retrieved IP address associated with a terminal can be used to uniquely identify a requesting terminal (and thus its user). Consequently,



one may either directly retrieve corresponding email configuration settings from an email configuration database or map a retrieved IP address to an associated MSISDN (LOOKUP) of the phone prior to accessing the email configuration database using the determined MSISDN.

Cover simply fails to disclose such a limitation. The Examiner cites to "col. 2, lines 41-60; col. 9, lines 61-col. 10, line 5" as disclosing the claimed limitation on page 3 of the Final Office Action. However, these recited portions of the Cover reference only disclose a requesting computer that provides an email address or generated Uniform Resource Identifier (URI) based on the email address to a configuration computer system. Importantly, an e-mail address generated by a requesting computer is not a network address of the terminal, as required by the claims. Indeed, the email address provided by a requesting computer does not uniquely identify the requesting computer, as a network address or IP address is well known to provide.

In stark contrast to a network address, an email address provided by a requesting computer does not uniquely identify the requesting user in a network environment, and thus can not be used to uniquely identify a user of the requesting computer in the manner disclosed and claimed. Accordingly, the Examiner's citation to Cover is insufficient to anticipate claims 1, 7, 8, and 10.

- c. Cover fails to disclose the claim limitations of claims 1, 7, 8, and 10 relating to contact between the email proxy and email server based on the retrieved email configuration settings.**

Cover fails to disclose the claim limitations of claims 1, 7, 8, and 10 requiring further communication between the email proxy and an email server using the retrieved email configuration settings. In support of the rejection, the Examiner cites to "col. 10, lines 42-60, col. 12, lines 2-42, col. 13, lines 3-15, and col. 14, line 25-col. 15, line 42" as disclosing this claim limitation on page 3 of the Final Office Action.

Applicants submit that the cited portions of the Cover reference are directed to a situation wherein “an electronic mail domain may include a plurality of servers,” (See Col. 10, lines 48-49 of Cover). In this situation, Cover discloses that a “server 361A may initially receive the identifier and redirect the identifier to server 361C because electronic mail for the user associated with the identifier tsmith@domain360.com is to be physically stored at server 361C.” (See Col. 10, lines 55-60). However, in this situation, the initial server 361A never retrieves any configuration settings. Rather, it simply forwards the request for configuration settings to a second server 361C.

Accordingly, the Examiner can not rely upon the cited portion of Cover as anticipating the claim limitations requiring (1) the retrieval of configuration settings by the email proxy, and (2) the communication with an email server using the retrieved configuration settings, as the server 361A never retrieves any configuration settings, and thus does not use “retrieved configuration settings” to communicate with server 361C.

Accordingly, the Examiner’s citation to Cover is insufficient to anticipate claims 1, 7, 8, and 10.

**d. Cover fails to disclose the claim limitation of claim 7 relating to the retrieval of email from the email server on behalf of the terminal.**

Cover fails to disclose the claim limitation of, for example, claim 7, requiring the forwarding of the email retrieval request to the email server, and also fails to disclose the actual retrieval of an email message by the email proxy and forwarding of the email message to the requesting terminal. In support of the rejection, the Examiner cites to “col. 14, line 27-col. 15, line 15 and col. 15, lines 26-50” of Cover as disclosing this claim limitation. These cited portions of the Cover reference, however, merely disclose an example XML implementation of email configuration settings that are retrieved and sent back to the requesting computer system or to a

consuming computer system (See Fig. 2 of Cover). Importantly, the configuration computer system 202 of Cover never forwards the email retrieval request to an email server. In fact, Cover does not disclose an "email request" at all, but only an "email configuration request."

Similarly, Cover fails to disclose that the configuration computer system 202 cited by the Examiner actually retrieves any email from the email server, as required by the claims. Rather, Cover merely discloses that the configuration computer system retrieves email configuration information and sends the configuration information to a requesting or consuming computer system. Cover never discloses a configuration computer system that actually retrieves an email message from an email server.

Accordingly, the Examiner's citation to Cover is insufficient to anticipate claim 7, and Applicants respectfully request the withdrawal of the 35 U.S.C. § 102 rejection, and the issuance of a Notice of Allowance.

- e. Cover fails to disclose the claim limitation of claim 8 relating to the modification of the email request and forwarding of the modified email request to the email server.**

Cover fails to disclose the claim limitation of, for example, claim 8 requiring modifying the email sending request using the email configuration settings and forwarding the modified email sending request to an email server. The Examiner cites to "col. 8, lines 59-67 as disclosing this claim limitation.

These cited portions of the Cover reference, however, merely disclose the modification of an email address identifier in an email configuration request by a requesting computer system. Claim 8 requires the modification of an email sending request. Col. 8, lines 59-67 of Cover disclose that it is the requesting computer itself that modifies the identifier, not the configuration computer system as asserted by the Examiner in the last Final Office Action. Accordingly, this

disclosure can not be used to anticipate the claim limitation that an email sending request is modified by the email proxy computer system.

Accordingly, the Examiner's citation to Cover is insufficient to anticipate claim 7.

**f. Cover fails to disclose the claim limitation of claims 7 and 8 relating to receipt of an email retrieval request (claim 7) or an email sending request (claim 8)**

Finally, specifically regarding Cover fails to disclose the claim limitation of, for example, claims 7 and 8, requiring receipt of an email retrieval request or an email sending request. The most recent office action fails to specifically address this claim limitation on pages 4 and 5 of the Final Office Action.

Applicants submit that the Cover reference, at most, discloses the modification of an email address identifier in an email configuration request received by a requesting computer system. Claims 7 and 8, in contrast, require receipt of an email sending or receiving request by an email proxy.

The Cover disclosure of an email configuration information request is simply not the same as an email sending or receiving request. In the case of Cover, the configuration system responds with configuration information so that a requesting computer system can configure itself to send and receive email.

The currently pending claims, in contrast, require a request for sending or receiving actual email messages. In the case of a request for email, the email proxy set forth in claim 7 would respond to the request with one or more actual email messages. In the case of a request to send email, the email proxy set forth in claim 8 would be provided with one or more actual emails. In this regard, an email sending or retrieval request is not equivalent to an email configuration information request.

Accordingly, the Examiner's citation to Cover is insufficient to anticipate claims 7 and 8.

**4. Conclusion**

For all the above reasons, Applicants respectfully submit that the Final Office Action mailed on December 4, 2008 is insufficient and that the rejections in the Office Action should be withdrawn. Additionally, Applicants submit that all claims are in condition for allowance over the cited art of record and respectfully request a Notice of Allowance.

Applicants thank the Examiner and his supervisor for providing time to discuss these matters with the Inventors and counsel on February 17<sup>th</sup> at 10:00 AM Eastern Standard Time.

Applicants have included example claim amendments for discussion purposes only. As set forth above, Applicants submit that the claims are allowable in their un-amended form.

Should the Examiner have any questions about this matter prior to the interview date and time, the Examiner is invited to call the undersigned at (312) 913-0001.

Respectfully submitted,  
**McDonnell Boehnen Hulbert & Berghoff LLP**

Date: February 12, 2009

By: 

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